

REMARKS

Claims 1, 2, 5, 7 and 9-13 are pending in the above-identified application. Support for the change to substituent "X" is found at column 2, lines 23-24 of the granted patent, for example. Support for the change to the phrase "alkali soluble resin" is found at column 4, lines 12-14 and lines 33-38. Further support is also found in Resin EPVP1 and EPVP2 prepared in Referenced Examples 1 and 2 at columns 8-9. Claim 3 has been cancelled, since the formulas (I) and (Ib) have become the same structure. Claims 4 and 6 have been cancelled as the claims became redundant with respect to claims 11 and 12. The formula in claims 5 and 7 has been amended to be consistently formula (I).

Allowable Claims

Claims 3-8, 10 and 11 have been indicated as being allowable and or merely objected to as depending upon rejected base claims. Claim 3 has been incorporated into claim 1. Since all of the presently pending claims ultimately depend from claim 1, all of the presently pending claims have been placed into allowable form.

Removal of Issues under 35 U.S.C. §103(a)

Claims 1, 2, 9, 12 and 13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Irving '517 (USP 4,439,517). The basis for this rejection has been removed upon the incorporation of claim 3 into claim 1. Consequently, it is requested that this rejection be withdrawn.

Remarks Concerning Information Disclosure Statement

Submitted with this Amendment is an Information Disclosure Statement (IDS). The IDS provides information regarding five references cited in an Official Action which issued in connection with the corresponding Japanese patent application in 2004. Note that the three published Japanese applications listed on the PTO-1449 form are submitted together with "Machine" English translations thereof. All of these references fail to disclose the use of any of the compounds recited in Formula (I) of the present claims.

The other listed reference, ie. Niki '706 (USP 5,658,706) corresponds to Japanese published application JP 07-134419-A which was cited in the Japanese Official Action. Niki '706 fails to disclose the use of a polyvinyl phenol-based resin in which the phenolic hydroxyl group is partially alkyl-etherified, as recited in the present claims. Further, Niki '706 fails to disclose compositions containing a cross-linking agent, as in the present claims. Consequently, significant patentable distinctions exist between the present invention as recited in the present claims, and Niki '706, such that this reference fails to form an adequate basis for alleging obviousness.

A fifth reference cited in the Japanese Official Action was Japanese published application JP 10-301264-A which corresponds to Fukui '601 (USP 5,891,601) which was cited during the prosecution of the application which ultimately granted as the patent forming the basis of the present Re-issue Application. It is noted that Fukui '601 discloses compositions relating to "positive" resists which do not contain a cross-linking agent. On the other hand, the

compositions recited in the present claims are “negative” resists and require the presence of a cross-linking agent. Therefore, significant patentable distinctions exist between the present invention and Fukui ‘601, such that this reference fails to form an adequate basis for alleging obviousness.

In addition to the above, it is further submitted that both Niki ‘706 and Fukui ‘601 fail to recognize the unexpected, advantageous properties exhibited by the compositions of the present invention as evidenced by the comparative test results provided in the specification of the present patent. In this regard, note that advantageously superior effective sensitivity, resolution and/or profile properties are achieved by examples falling within the present invention over an advantageously small temperature dependency range as summarized in Table 1 and 2 at columns 10 and 13 of the present patent. Further in addition to the above, enclosed is a Declaration submitted under 37 CFR 1.132 (hereinafter the “Suetsugu Declaration”) which provides still further evidence of the unexpected advantageous properties exhibited by the compositions of the present invention. The comparative test results of the Suetsugu Declaration show that compositions of the present invention containing a compound in accordance with formula (I) exhibit advantageously improved patterned properties over a smaller temperature dependency range, as well as better resolution and profile properties, as compared to compositions containing compounds having only one pyridine ring in the chemical structure.

It is submitted for the reasons stated above that all of the presently pending claims define patentable subject matter such that the present application should be placed in to condition for allowance.

Application No. 10/664,355
Amendment dated August 10, 2005
Reply to Office Action of March 10, 2005

Docket No.: 2185-0698P

If any questions remain regarding the above matters, please contact Applicant's representative, Andrew D. Meikle, (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a two (2) month extension of time for filing a reply in connection with the present application, and the required fee of \$450.00 is attached hereto.

Dated: August 10, 2005

Respectfully submitted,

By 

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Enclosure: Suetsugu Declaration